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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,909

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Robert S. Fielmann

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EXAMINER

LIEU, JULIE BICHNGOC

ART UNIT

PAPER NUMBER

2612

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/627,909	<b>Applicant(s)</b> FIELMANN, ROBERT S.	
	<b>Examiner</b> Julie Lieu	<b>Art Unit</b> 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office action is in response to Applicant's response and affidavit file August 23, 2007. New claims 21 and 22 have been added.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is again rejected under 35 U.S.C. 101 because a person's awareness of the presence of the door is not discreet and tangible.

#### ***Claim Rejections - 35 USC § 112***

4. Claim 20 is again rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, fails to disclose how a person's awareness would be detected so that it would be determined whether the person is unaware of the presence of the door.

***Claim Rejections - 35 USC § 103***

5. Claims 1-12 and 21 are again rejected under 35 U.S.C. 103(a) as being anticipated over Nykerk (US Patent 4,987,402).

Claim 1:

Nykerk discloses that there is a wide variety of available devices for detecting the presence of a person near a door and for providing a warning of the presence at a door when the person is in close proximity to the door, comprising:

- a. a detector device 59 having a detection range for being positioned in at least close proximity to a door in a position to detect the person in close proximity to the door and within the detection range of the detector device; and
- b. an audio alarm device, an alarm, for providing an audible warning to the person in proximity to the door, the audible alarm device associated with the detector device so that the audible alarm device provides the audible warning in response to the detection of the person by the detector device.

See fig. 4 and abstract.

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The system of Nyerk's would warn a person that he/she must move away from the object, that is the door, or alarm will be trigger (see abstract.) Thus, a person who is approaching the door would know not to touch the door, or in the case of a blind person, avoid colliding with it.

Regarding mounting the device to a building, it would have been obvious to one skilled in the art that the device could be used in a building environment instead of a vehicle environment and it is within the knowledge of a skilled artisan to modify the system so that it would be feasible to in the building environment.

The reference fails to clearly disclose the specific detection range of the detector device is less than 5ft and whether the door is substantially transparent. However, a detection range of less than 5ft is conventional in the art since the system is desired to detect a person within close proximity to the door so that false warning would not be triggered in the case that passer-bys only passes by the vehicle. Therefore, one skilled in the art would have readily recognized to use a detection range of 5ft as desired.

Claim 2:

Nyerk suggests the use of different detection devices including motion detectors.

Claim 3:

The detector in disclosed in Nyerk comprises a body heat sensitive detector, i.e. infrared detectors (INVISIBEAM).

Claim 4:

Nyerk discloses a voice module to record voice messages to warn a person approaching the door of the presence of the door. See abstract and col. 6, last paragraph.

Claim 5:

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Nykerk discloses a controller for the motion detector for adjusting the detection range of the motion detector device. See col. 4, last paragraph and col. 10, second paragraph.

Claims 6 and 8-10:

Nykerk fails to discuss in details the configuration of the detector device and the audible alarm device in conventional system as to whether or not they are not contained within the same housing or pouch. Further, it appears that the Nykerk device does not have a self-contained power. Nonetheless, the integration of parts in the same housing and adding a power supply in the device would not be considered an inventive step because the function of the device would not thereby be modified. It would have been obvious to one skilled in the art to use an attractive shape for the device because aesthetic is always preferred.

Claim 11:

Nykerk disclose a self-contained power supply 11.

Claim 12:

Nykerk fails to disclose specifically that the volume of the audible alarm system can be adjusted. However, one skilled in the art would have readily recognized providing this feature in the system disclosed in Nykerk because of convenience.

Claims 21 and 22:

Regarding these claims, one skilled in the art would have readily recognized using different means of mounting the device and where to mount it. The claimed features of magnetic mounting and mounting it on a screen door would not be considered to be an inventive step because it only presents a choice in design as where to mount the device and how the device would be mounted depending on feasibility, cost, and availability of parts.

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6. Claims 14-18 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Nykerk (US Patent 4,987,402) in view of Thacker (US Patent No. 6,359,564).

Claim 14-18:

The rejection of these claims recites the discussion in the rejection of claims 1-12, except they are method claims. Regarding mounting the device to a building, it would have been obvious to one skilled in the art that the device could be used in a building environment instead of a vehicle environment and it is within the knowledge of a skilled artisan to modify the system so that it would be feasible to in the building environment.

*Allowable Subject Matter*

7. Claims 13 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Applicant's Arguments*

8. The Applicant has presented the following arguments:

Argument 1:

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The Applicant argues that the independent claims 1 and 14 recite that the device is mounted to a building while Nyerck's device is a car alarm therefore cannot be mounted in a building.

Argument 2:

"Thacker discloses an occupancy status indicator for a cubicle. Cubicles do not have doors never mind substantially transparent doors. The subject matter of occupancy status indicators does not suggest an at least substantially transparent door because occupancy status indicators are generally used with opaque doors as in photography dark rooms and bathrooms. Therefore, the invention, requiring a detection device in at least close proximity to a substantially transparent door as claimed, is not taught or suggested by any combination of the references."

Argument 3:

"The independent claims are also patentable for a second reason. In responding to Applicant's arguments in the Amendment filed February 19, 2007, Examiner indicated in the Office Action of May 14, 2007, that the claims were not allowable because the "claims do[] not recite that the alarm is to warn a person of the impending danger [of a collision between a person and the substantially transparent door." The claims have been amended to recite "warning a person approaching a substantially transparent door ... so that the person can avoid colliding with the door." Neither Nykerk, nor Thacker in any way disclose, teach or suggest the invention as claimed. Therefore the independent claims are patentable."



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Argument 4:

Regarding the 101 rejection, the Applicant has argued: "Furthermore, the patentable subject matter rejection of claim 20 is in tension with both *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 68 USPQ2d 1154 (Fed. Cir. 2003) and *Rapoport v. Dement*, 254 F.3d 1053 (Fed. Cir. 2001). In *Rexall*, the Federal Circuit construed "A method of treating or preventing macrocytic-megaloblastic anemia ...which comprise administering a daily oral dosage of a vitamin to a human in need thereof." *Rexall*, 342 F.3d at 1330. It held that the limitation "to a human in need thereof" requires that the person taking the vitamin preparation recognize and appreciate the need to treat or prevent macrocytic-megaloblastic anemia. *Id.* at 1334. In other words, "administering the claimed vitamins ... for some purpose other than treating or preventing macrocytic-megaloblastic anemia is not practicing the claim." *Id.* In *Rapoport*, "A method for treatment of sleep apneas comprising administering [a pharmaceutical] ... to a patient in need thereof" was construed as requiring the method to be practiced with the intent to achieve the treatment of sleep apnea. *Rapoport*, 254 F.3d at 1061. Thus, in both *Rapoport* and *Rexall*, the Federal Circuit expressly read an intent requirement into the claimed method invention. In neither case, was the Federal Circuit concerned about patentable subject matter (35 U.S.C. § 101)."

***Response to Applicant's Arguments***

9. Applicant's arguments filed February 19, 2007 have been fully considered but they are not persuasive.

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Response to Argument 1:

For response to this argument, refer to the rejection above.

Response to Argument 2:

The use of Thacker is to show a teaching that the concept of an alarm that automatically turns itself off after a predetermined period of time to save energy is conventional in the art and one skilled in the art would have readily recognized applying this concept in the Nykerk system to save energy.

Response to Argument 3:

It is submitted that in the Office action May 14, 2007, the examiner's intention was to indicate that the Applicant argued features that are not recited in the claim, the examiner did not indicate that the claims were not allowable because it did not include such feature.

Response to Argument 4:

It should be noted that, in the two cited law cases, the feature is different from the claimed invention in that the need of the person who needs or should be treated has been determined by that person's physician or at least by that person himself/herself while the present invention provides the warning, as long as it detects someone near the door, regardless whether a person is aware/or unaware of the door. The present invention is not capable of determining whether a person who is approaching the door is unaware of the door by itself.

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Awareness/unawareness is abstract and cannot be determined unlike the need of a person of a treatment can be determined by physical examination.

*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Lieu whose telephone number is 571-272-2978. The examiner can normally be reached on MaxiFlex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on 571-272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Julie Lieu', with a long, sweeping horizontal stroke extending to the right.

Julie Lieu  
Primary Examiner  
Art Unit 2612

Sept 12, 2007